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TO: NGUYEN, M.
Group Art Unit 2176

FAX NO. 703-872-9306

FROM: Jimmy L. Heisz

RE: Serial No.: 09/234,351
Attorney Docket No.: WILLIAMS 2
REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

DATE: June 1, 2004

PAGES: 8 (including cover page)

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Intellectual Property Law & Related Matters

FACSIMILE TRANSMISSION

TO: Nguyen, M.
Group Art Unit 2176

FAX NO. (703) 872-9306

FROM: Jimmy L. Heisz
Hitt Gaines, P.C.

RE: Serial No. 09/234,351
Attorney Docket No.: M. WILLIAMS 2
REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

DATE: March 1, 2004

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HITT GAINES, P.C.

Intellectual Property Law & Related Matters

FACSIMILE TRANSMISSION

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"Reply under 37 CFR 1.116
--Expedited Procedure--
Examining Group 2176

ATTORNEY DOCKET NO. M. WILLIAMS 2

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Marvin L. Williams

JUN 01 2004

Serial No.: 09/234,351

Filed: January 20, 1999

Title: SYSTEM AND METHOD FOR ESTABLISHING RELATIONSHIPS
BETWEEN HYPERTEXT REFERENCES AND ELECTRONIC MAIL
PROGRAM INCORPORATING THE SAME

Grp./A.U.: 2176

Examiner: Nguyen, M.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that this correspondence is being facsimile
transmitted to the Patent and Trademark Office (Fax No.
(703)872-9306 on: 03/01/2004 (date).

DEBBIE SZWARZBER
typed or printed name of person signing this certificate

Debbie Szwarszber
Signature

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

In response to the Examiner's Action mailed January 2, 2004, the Applicant has carefully considered this application in connection with the Examiner's Action and respectfully requests reconsideration of this application in view of the following remarks.

The Applicant originally submitted Claims 1-27 in the application. The Applicant previously amended Claims 1-2, 5, 10, 11, 14, 19-20 and 23 and has not canceled or added any claims. Accordingly, Claims 1-27 are currently pending in the application.

I. Rejection of Claims 1-27 under 35 U.S.C. §103

The Examiner has rejected Claims 1-27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029,164 to Birrell, *et al.* ("Birrell") in view of U.S. Patent No. 5,790,793 to Higley. As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Birrell discloses a method and apparatus for organizing and accessing electronic mail messages. Birrell describes the receipt of data records in an index server, where the data records are parsed into words, and stored in a full-text index. Labels are added to the data records and the full-text index so that the data records can be accessed by searching using queries that include the words and labels of the data records. (Abstract).

Birrell does not teach or suggest an e-mail program or a system of establishing relationships between hypertext references *contained in e-mail messages* where a message parser is used to locate hypertext references. In Birrell the hypertext link is not in the email. Instead a link is created to the email by the Birrell system. The Examiner cites col. 11, lines 54-63, of Birrell for the proposition that a parser locates hypertext references in first and second email messages. In fact, the cited passage from Birrell does not support this statement. This passage of Birrell describes how email messages are presented to a user, who can access and recover a message by clicking on a "hot-link" to the message that was created by the system described in Birrell. This hot-link is created and transmitted to the user in HTML format, but is not a hypertext link that is found in the originally received email as described in the present application.

As stated in the previous office action, a careful reading of Birrell clearly reveals that the "hot links" described therein are not referrals to a hypertext reference contained in an e-mail message but, instead, refer to a link created by the system to identify a stored e-mail message so that it can be found as the result of a user query. Thus, Birrell does not teach or suggest a method or program that includes finding hypertext references placed in first and second e-mail messages by senders and building hypertext messages containing the hypertext references and associating the hypertext references with the senders as recited in independent Claims 1, 10 and 19.

Higley does not overcome the shortcomings of Birrell. Higley describes a method and system for sending and receiving Uniform Resource Locators (URLs) in electronic mail over the Internet. If the message includes an URL, the URL is looked up when the received document is read or browsed so that the information corresponding to the URL can be displayed without necessarily displaying the received message. If the received document is a HTML type, the document can be